

REMARKS

An Office Action was mailed on December 10, 2003. Claims 1-15 are pending.

The specification is objected to because of improper language in the Abstract and because the title is not descriptive. Responsive thereto, Applicant has amended the title as recommended by the Examiner. Applicant has also amended claim 4 to overcome the rejection under 35 U.S.C. §112, second paragraph by removing superfluous claim language at the end of the claim.

Claims 1-3, 5, 6, and 10-15 are rejected under 35 U.S.C. §102(e) as being anticipated by Matsuda et al. (U.S. Patent 6,253,167), while claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuda in view of Shackelford (U.S. Patent 6,554,679). Claims 7-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Matsuda and further in view of Yokoi (U.S. Patent 5,966,526).

With respect to claims 1-4, 10, 12 and 14, Applicant has amended such claims as supported for example on page 16, lines 6-17 of the specification and FIG. 5, to provide for a plurality of motion icons that are serially toggled by the user to determine the type of motion parameters, and then a separate selection icon located adjacent the motion icons to establish the motion parameter selected by the user. Figure 9 of Matsuda et al. clearly fails to teach or reasonably suggest this type of functionality, see column 11, line 45 through column 12, line 10, since the action panel of FIG. 9 requires a one-click operation. This is quite different from the teaching of the present invention as illustrated, for example, in FIG. 5, wherein the motion icons 208a-d are serially toggled and then selected using the Decision icon 210 located adjacent the motion icons. Accordingly, the Examiner is respectfully requested to withdraw the §102(e) rejection in view of Matsuda et al.

With respect to the remaining claims, Applicant has amended such claims to require that the raising of a virtual game character requires the steps of generating an event for virtual marrying of a marriageable virtual game character of the one or more virtual game characters by informing one or more other virtual game characters of said marriageable virtual game character, wherein a premarital interview is arranged, solicited and conducted by said marriageable virtual

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game character. Support for such amendments is found in connection with Figures 15-19 and the specification related thereto (see, for example, page 25, lines 8-12).

Matsuda et al. fails to disclose anything related to virtual marriage between virtual characters. Accordingly, the Examiner is respectfully requested to withdraw the §102(e) rejections to claims 5, 6, 11, 13 and 15.

Yokoi discloses the coupling of two virtual characters and a breed character born by the coupling. Column 12, lines 35-56 of Yokoi discusses that coupling of the virtual characters can only occur if the creatures have reached a certain age or are individually mature. Such decision is based purely on a single character's ability to be married (see FIG. 12, step SP73). However, Yokoi fails to teach or reasonably suggest the details of the pre-marriage selection as illustrated in FIGS. 15-19 of the present application and as currently set forth in claims 5-8, 11, 13 and 15. The virtual marrying of the present invention requires active communications between the potential marrying candidates through a premarital interview arranged, solicited and conducted by said marriageable virtual game character. One skilled in the art would not consider the claimed invention to be obvious in view of the combined teachings of Matsuda et al. and Yokoi because neither reference contemplates or even comes close to suggesting the complexities involved in the claimed premarital interview process.

In addition, in order to establish a case of *prima facie* obviousness there must also be shown a motivation to combine the teachings of the Matsuda et al. and Yokoi references to arrive at the claimed invention. To that end, some suggestion of the desirability to combine the references must be found and demonstrated in the references. This burden cannot be satisfied by simply asserting that the modification would have been "well within the ordinary skill of the art."

As the CAFC stresses for a § 103 rejection to stand, the Examiner is required to show with evidence the motivation, suggestion or teaching of the desirability of making the specific combination at issue. That evidence is required to counter the powerful attraction of a hindsight-based obviousness analysis. See, for example, *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433 (Fed. Cir. 2002) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"). It is

respectfully submitted that this involves more than a mere bald assertion that it would be obvious to combine the cited references. *In re Lee* requires that the record must state with particularity all the evidence and rationale on which the PTO relies for a rejection and sets out that it is necessary to explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

Applicant submits that there is no suggestion of the desirability to combine the Yokoi and Matsuda et al. references, nor is there any motivation demonstrated in either of the references to combine them, nor is there any suggestion in either reference to adapt their disclosures to the unique construction of the present invention requiring the premarital interview between virtual characters as currently claimed. Thus, to combine the teachings of two references that are distinct from the claimed invention can only result in a combined teaching that is also distinct from the claimed invention, as both references clearly fail to teach or reasonably suggest the claimed features as currently set forth. For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1, 3-8 and 10-15, consisting of independent claims 1, 5 and 10-15 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,

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